

Remarks

The claims were amended in accordance with the amendments above. The amendments to the claims are being made merely to clarify the invention. All of the amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

Applicant appreciates the courtesies extended during the telephonic interview with the Examiner February 27, 2008. While no agreement was reached during the interview, Applicant believes that the present amendments place the claims in condition for allowance, for at least the reasons set forth below.

§112 Rejections

In the Office Action dated January 25, 2008, claim 12 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite. In particular, the Office noted that claim 12 repetitively stated that a first control and a second control were operatively configured to position at least one of the first, second, and third members to separately actuate the plurality of distal arms. Claim 12 has been amended to clarify that the second control is operatively configured to position at least one of the first, second, and third members to separately actuate the plurality of *proximal* arms. The Office further noted that claim 12 stated that the first and third member were both operative to internally engage the proximal ring. Claim 12 has been further amended to clarify that the first member is operative to internally engage the *distal* ring. Applicant submits that these amendments have obviated the §112 rejections, and respectfully requests that the §112 rejections of claim 12 be withdrawn.

Claim 17 was also rejected under 35 U.S.C. §112. In particular, the Office noted that there was insufficient antecedent basis for the term “arresting member,” and that the claim depended from canceled claim 16. Claim 17 has been amended to delete the “arresting member” limitation, and to depend from claim 12. Applicant submits that these amendments have obviated the §112 rejections, and respectfully requests that the §112 rejections of claim 17 be withdrawn.

§102 Rejections

Claims 1, 8, 9, 11-13, 15, 17 were rejected under 35 U.S.C. §102(b) as being unpatentable over Huebsch et al. (U.S. 5,853,422). Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. In addition, the elements in the prior art reference must be arranged as required by the claim. MPEP 2131 (emphasis added).

Applicant submits that Huebsch et al. fails to teach or suggest all of the limitations recited in amended independent claim 1, particularly in the arrangement required by the claim. For instance, amended independent claim 1 recites “a second actuating member of the elongate implement portion having a second set of prongs internally engaged to the center ring of the anastomosis device, the second set of prongs being configured to deflectably disengage from the center ring of the anastomosis ring device when the anastomosis ring device is actuated.” Huebsch et al. fails to teach or suggest such limitations, among others, particularly in the arrangement required by amended claim 1. The Office has cited item 240 of Huebsch et al. as allegedly teaching a second actuating member. However, an actual reading of the Huebsch et al. reference reveals that item 240 is actually a “locking bore.” See Col. 7, l. 1. To the extent that the Office maintains that Huebsch et al. teaches the second actuating member recited in amended claim 1, the Office is respectfully requested to cite whatever portions of the Huebsch et al. specification may support the Office’s position, rather than merely relying on the drawings, which clearly do not alone teach the second actuating member of claim 1 in accordance with §112. Accordingly, Huebsch et al. fails to anticipate amended claim 1 in accordance with MPEP 2131. Applicant therefore respectfully requests that the rejection be withdrawn.

Furthermore, amended independent claim 1 recites “the first and second controls are operable to be selectively positioned to contemporaneously perform both of the following: (i) reduce a first longitudinal separation between the center ring and a selected one of the proximal and distal rings thereby causing actuating of the interposed hinged arms located between the center ring and the selected one of the proximal and distal rings of the ring device, and (ii) maintain a second longitudinal separation between the center ring and the other ring thereby

preventing actuating of the interposed hinged arms located between the center ring and the other ring of the ring device to configure the anastomosis ring device into a partially actuated ring shape having one set of at least partially actuated arms and one set of unactuated arms.” Such controls are nowhere to be found in Huebsch et al. Indeed, the actuating device of Huebsch et al. actually appears to actuate all arms simultaneously, rather than actuating one set of arms while preventing actuation of another set of arms as recited in amended claim 1. See Col. 6, ll. 42-53. To the extent that the Office disagrees, the Office is respectfully requested to point to where in the specification of Huebsch et al. that such controls are taught, rather than merely referencing the drawings of Huebsch et al., so that Applicant will have a full and fair opportunity to respond. In any event, because Huebsch et al. fails to teach or suggest such limitations, this is yet another reason why Huebsch et al. fails to anticipate amended claim 1 in accordance with MPEP 2131. Applicant therefore again respectfully requests that the rejection be withdrawn.

Amended independent claim 12 recites “when said center circular portion of said anastomotic ring device is engaged directly with said second member of said applier, movement of said center circular portion is constrained to movement of said second member.” Huebsch fails to teach or suggest such limitations, among others, particularly in the arrangement required by amended claim 12. To the extent that the Office disagrees, the Office is respectfully requested to point to where in the specification of Huebsch et al. that such controls are taught, rather than merely referencing the drawings of Huebsch et al., so that Applicant will have a full and fair opportunity to respond. Ultimately, Huebsch fails to anticipate amended claim 12 in accordance with MPEP 2131. Applicant therefore respectfully requests that the rejection be withdrawn.

Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty.

§103 Rejections

Claims 10 was rejected under 35 U.S.C. §103(a) as being obvious over Huebsch et al. in view of Adams (U.S. 6,632,227). Under MPEP 2143.03, in order to establish a *prima facie* case of obviousness, the Office must give due consideration to all of the limitations of a claim. The Office must also sufficiently establish a motivation to combine or modify the teachings of the

prior art in order to reach a claimed invention in accordance with MPEP 2143.01. Obviousness rejections “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1395-97 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). For at least the reasons set forth below, Applicant respectfully submits that the combined art of record fails to render any of the present claims obvious.

As noted above with respect to the §102 rejections of amended claim 1, Huebsch et al. fails to teach or suggest certain limitations of amended claim 18. Applicant further submits that, even in combination with Huebsch et al., Adams fails to make up for this deficiency of Huebsch et al. Applicant therefore submits that the combined art of record fails to teach or suggest all of the limitations of claim 1. Accordingly, Applicant respectfully submits that the combined art of record fails to render present claim 1 obvious in accordance with MPEP 2143. Furthermore, claim 10 depends from claim 1, and include additional limitations beyond those recited in amended claim 1, thus forming independent bases for non-obviousness. Nevertheless, since the combined art of record fails to render amended independent claim 1 obvious by failing to teach or suggest all of the limitations of amended claim 1, the combined art of record also fails to render claim 10 obvious in accordance with MPEP 2143. Applicant therefore respectfully requests that the rejection be withdrawn.

Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for non-obviousness.

Conclusion

While several distinctions have been noted over the art of record, Applicant notes that there are several other limitations recited in the present claims which are neither taught nor suggested by the art of record. Applicant expressly reserves all rights and arguments with respect to distinctions not explicitly noted herein. In addition, to the extent that the amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. To the extent that any particular statement or argument by

the Office in the pending Office Action has not been explicitly addressed herein, the same should not be construed as an acquiescence or admission by the Applicant that such statements or arguments by the Office are accurate or proper.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance. Should the Examiner wish to discuss the amendments or arguments made herein, Applicant invites the Examiner to contact the undersigned at (513)651-6889 or via e-mail at kwales@fbtlaw.com.

The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully Submitted,

A handwritten signature in cursive script, reading "Kenneth S. Wales", written in black ink.

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